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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,623	07/28/2003	Raffaella Delvecchio	59920	5814

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EXAMINER

MOSSER, KATHLEEN MICHELE

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,623	Applicant(s) DELVECCHIO ET AL.	
	Examiner Kathleen Mosser	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/04/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9, 10, 12, 13, 15-17, 19, 20, 22-27, 29-31, 33, 34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) 4, 8, 11, 14, 18, 21, 28, 32, 35 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In response to the amendment filed 08/04/2006, claims 1-38 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-3, 5-6, 9-10, 12, 15-17, 19-20, 22, 24-27, 29-30, 33-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 2002/0142275) in view of Castellano (US 2853802).

Wexler teaches a system and method for its use including: a flexible elongate member (chain 12); at least one sensor (Figure 2, 30); and an audible indicator carried by said flexible elongate member for providing an audible indication based upon said at least one sensor (speaker 32 and its associated circuitry), as in claims 1 and 25. Wexler teaches the use of a visual indicator (claims 10, 16 and 33) through the use of LEDs, see at least paragraph 19. The sensor is carried on the indicator (claims 3, 17, 27 and 34) as is shown in Figure 2. The sensor senses user contact (claims 5, 19, 29 and 36) as is shown in paragraph 21. The audible indication includes at least one prayer (claims 9) see for example

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paragraph 27. The indicator is mounted on the housing (claims 15 and 24) as is shown in Figures 1-3. The visual indicator includes a religious image (the cross) as in claims 12 and 22.

Wexler fails to specifically teach that the flexible elongate member includes a plurality of beads (claims 1, 16, 25 and 33); or is arranged in a loop with a leg extending outwardly therefrom, and wherein said audio or visual indicator is carried at a junction between the loop and the leg (claims 2, 16, 26 and 33),

Castellano teaches a traditional style rosary including a flexible elongate member including a plurality of beads (Figure 1, elements 10 and 11) where the elongate member is arranged in a loop with a leg extending therefrom (Figure 1). The device also includes an aid for the user, in the form of visual plates indicating the mysteries arranged at the junction of the leg and the loop. It would have been obvious to one of ordinary skill in the art to modify the chain arrangement of Wexler with this more traditional style of rosary so as to maintain the traditional feel and appearance of the rosary (see Castellano col. 1: 61-67).

Neither Wexler nor Castellano teach a sensor that is activated by the users voice (claims 6, 20, 30, and 37). The examiner takes OFFICIAL NOTICE that the use of voice recognition software as an activator for various electronics is old and well-known in the computer related arts. Such devices allow the user to have hands free access to a plurality of devices. It would have been obvious to one of ordinary skill in the art to supplement the switches of Wexler with a voice recognition circuit so as to allow a disable of severely arthritic user to advance the prayer indicators of the invention.

2. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 2002/0142275) in view of Castellano (US 2853802) further in view of Bosmani (US 5505622).

Wexler/Castellano teach all aspects of the invention as shown above but fail to specifically teach that the visual indication includes prayer text (claims 13 and 23). Bosmani teaches an electronic rosary device which includes a display (element 7) for outputting prayer text to a user (col. 2: 1-4, 23-28). It would have been obvious to one of ordinary skill in the art to incorporate this feature into the Wexler/Castellano

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system so as to allow the user to view the text of the prayer or mysteries they were reciting and aide the user is memorizing the proper prayers used in the recitation of the rosary.

3. Claims 7 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 2002/0142275) in view of Castellano (US 2853802) in view of Howard (US 2004/0076937).

Wexler/Castellano teaches all aspects of the invention as shown above but fails to teach recording the audible indications. Howard teaches this feature in at least paragraphs 8-9. It would have been obvious to one of ordinary skill in the art to incorporate the ability for a user to record the prayers so as to allow the user to hear the prayers as spoken by a relative or other loved one (see Howard paragraph 27).

Allowable Subject Matter

4. Claims 4, 8, 11, 14, 18, 21, 28, 32, 35 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Response to Arguments

5. Applicants amendments to the claims have overcome the previous rejections under 35 USC 112, first paragraph and the objections to the claims under 37 CFR 1.75(c).

6. Applicant's arguments filed 08/04/2006 have been fully considered but they are not persuasive.

7. Applicant asserts that the combination of Wexler and Castellano is improper. In support of this assertion the applicant asserts that it would be "redundant and unduly complicated to replace the simply carrying chain of the Wexler prompter with a chain and bead rosary" given that the rigid carrying case of Wexler already prompts the user and tracks prayers. However, the examiner notes, that with respect to at least claim 1, the only modification to Wexler is to provide a beaded chain. The chain of this claim is not used to track the prayers, does not have the functionality or specific features commonly associated with the rosary, and under a broadest reasonable interpretation may be just decorative. In addition to the above motivation to combine the inventions the examiner asserts that the use of a simple beaded chain in

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the Wexler invention would have been a modification well within the skill of one of ordinary skill in the art, as simple beaded chains are perpetually well known. Further, the applicant has provided no arguments against the specific motivation provided by the examiner in the prima facie case of obviousness shown above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kathleen Mosser
Primary Examiner
Art Unit 3715

October 5, 2006